

REMARKS

The Office Action dated December 18, 2002, has been received and carefully considered. Claims 1-8 are pending in the present application.

In this response, claims 9-12 have been added and claims 1, 4, 5, and 8 have been amended. Entry of added claims 9-12 and the amendments to claims 1, 4, 5, and 8 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE ANTICIPATION REJECTION OF CLAIMS 1, 3-5, 7, AND 8

On page 2 of the Office Action, claims 1, 3-5, 7, and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated by Foster (U.S. Patent No. 6,332,134). This rejection is hereby respectfully traversed with amendment.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a *prima facie* case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S.

International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id..

Regarding claims 1, 3-5, 7, and 8, the Examiner asserts that Foster teaches the present invention as claimed. However, Foster teaches a system wherein a cardholder transmits a request to pay directly to a card company (see column 8, lines 13-18). In contrast, the present application, as amended, claims receiving transaction information from a vendor at a secured network (see claims 1 and 5). Support for this claimed receiving process is found in Figure 1 and page 9, lines 15-16. This claimed receiving process is opposite to the teaching of Foster. Indeed, Foster teaches away from such a receiving process by teaching away from a prior art process whereby a merchant directly makes a credit card charge to a card company (see Figure 1 and Background of the Invention section).

Claims 3, 4, 7, and 8 are dependent upon independent claims 1 and 5. Thus, since independent claims 1 and 5 should be allowable as discussed above, claims 3, 4, 7, and 8 should also be allowable at least by virtue of their dependency on independent claims 1 and 5.

In view of the foregoing, it is respectfully submitted that the anticipation rejection of claims 1, 3-5, 7, and 8 is not proper at this time, and the withdrawal of such rejection is respectfully requested.

At this point it should be noted that claims 9-12 have been added to include certain additional subject matter that is not claimed, disclosed, or even suggested by Foster.

## II. THE OBVIOUSNESS REJECTION OF CLAIMS 2 AND 6

On pages 2 and 3 of the Office Action, claims 2 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster (U.S. Patent No. 6,332,134) in view of Srinivasan (U.S. Patent Application Publication No. US 2002/0077922). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll

words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner acknowledges that Foster does not disclose the use of a VPN for enabling secured communication of transaction information. However, the Examiner asserts that Srinivasan teaches a method of performing electronic transactions using a VPN such that it would have been obvious to modify Foster in view of Srinivasan so as to arrive at the present invention as claimed.

The Srinivasan reference was filed December 15, 2000, as U.S. Patent Application No. 09/738,531. Thus, the Srinivasan reference has an effective filing date of December 15, 2000.

Applicants respectfully submit that the invention disclosed and claimed in the present application was conceived prior to

both December 20, 2000. Applicants also respectfully submit that they were duly diligent in preparing and filing the present application from the date of conception of the invention disclosed and claimed in the present application to the filing date of the present application (i.e., December 28, 2000). Applicants support the above-stated submissions with inventor declarations under 37 C.F.R. § 1.131, which are submitted herewith, and which contain a showing of facts that clearly establish the above-stated submissions. Accordingly, the Srinivasan reference is not a proper prior art reference for application against the claims of the present application.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claims 2 and 6 is improper, and the withdrawal of such rejection is respectfully requested.

### III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the

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present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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